

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):	Patrick C. St. Germain	)	
Application No.	10/682,444	)	
Filed:	October 9, 2003	)	Group Art Unit: 3721
For:	APPARATUS FOR MAKING INTERFOLDED PRODUCT	)	
Examiner:	Sameh H. Tawfik	)	Attorney Docket No. <u>SSS-106</u>

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**RESPONSE UNDER RULE 116**

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This communication is submitted in response to the Office Action dated 23 February 2006 on the above-identified application. Reconsideration of this application is requested.

Applicant further requests that the Final Rejection made in the aforementioned Office Action be withdrawn. By the Examiner's own admission, the present rejection is a new ground of rejection based primarily on the newly cited U.S. Patent No. 5,088,707 to Stemmler. It is respectfully submitted, however, that applicant's amendments to the claims did not materially affect the scope of the presented claims, and thus did not necessitate the new ground of rejection. The outstanding rejection now relies on the newly cited reference as the principal reference and is based on a different statutory provision. Moreover, applicant traverses the officially noticed fact in rejecting claim 12. The officially noticed fact was so noticed for the first time in the Office Action dated 23 February 2006 placing all claims under a Final Rejection. Withdrawal of the Final Rejection is deemed warranted in this case.

In any event, the rejection of all claims under 35 U.S.C. 103(a) as unpatentable over Stemmler in view of Hermach is not warranted, and is hereby traversed.

As admitted by the Examiner, Stemmler does not describe interfolding of sheets that include at least one longitudinally extending fold line and at least one fold,

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respectively. Stemmler merely shows the interfolding of two conventional webs, W1 and W2, of material. Stemmler thus provides no motivation whatsoever for one of ordinary skill to venture beyond the four corners of this particular reference.

It is indeed well established that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive that supports the combination. Carella v. Starlight Archery, 231 USPQ 644, 647 (Fed. Cir. 1986). In the present case there is no such teaching, suggestion, or incentive.

Specifically, Stemmler is directed to the production of numerically correct stacks of interfolded sheets, an event that takes place downstream from the folding rolls. One of ordinary skill would have had no motivation to look upstream of the folding rolls when seeking to improve on Stemmler's approach for providing numerally correct stacks of a product. *A fortiori*, one of ordinary skill would have had no motivation whatsoever to look to the Hermach reference which has nothing to do with interfolding. Hermach addresses an entirely different problem – the folding (not interfolding) of newspaper sections. The Examiner is courteously invited to compare FIG. 5 of Hermach, which shows a folded newspaper product, with FIG. 6 of Stemmler which shows an interfolded web product. The products are very different from one another. The mechanisms required to produce each product are different as well. Hermach's apparatus is not similar but vastly different from that of Stemmler. This can be readily seen by comparing FIG. 2 of Hermach with FIG. 1 of Stemmler. The Examiner's contentions to the contrary notwithstanding, one of ordinary skill would not have had any desire even to try to produce an interfolded newspaper, much less a newspaper that is interfolded and also has an additional, longitudinal fold line. Query, how could one conveniently read such a newspaper?

In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must be either in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor is concerned. In re Deminski, 230 USPQ 313, 315 (Fed. Cir. 1986). Here the Hermach reference does not satisfy either criterion. It is necessary to consider "the reality of circumstances," In re Wood, 202 USPQ 171, 174 (CCPA 1979), in other words, common sense, in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem

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facing the inventor. It is respectfully submitted that one of ordinary skill in the web interfolding art and seeking to produce numerically correct stacks of interfolded sheets would not have turned to the newspaper folding art, which does not and cannot utilize interfolding, for improvements to machinery for making a unique interfolded product. One of ordinary skill would not have had any reason to do so. The attempted combination of elements from non-analogous sources, as here, and in a manner that seeks to reconstruct the applicant's invention only with the benefit of hindsight, is insufficient to establish a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the attempted combination. That knowledge cannot come from the applicant's invention itself. Diversitech Corp. v. Century Steps, Inc., 7 USPQ2d 1315, 1318 (Fed. Cir. 1988).

The present rejection of all claims under 35 U.S.C. 103(a) is not warranted and should be withdrawn.

Regarding claim 12, as pointed out hereinabove, the combined teachings of Stemmler and Hermach would only result in a wholly impractical newspaper product. One of ordinary skill would not even think of putting in a double fold "c" shaped fold in a newspaper, thus it is inappropriate for the Examiner in this case to take official notice to supply a claim element that even the attempted, impermissible combination of references fails to disclose. Here the Examiner is seeking to take official notice of a fact purportedly constituting the state of the art. Such a technical fact is subject to the possibility of rational disagreement among reasonable men and may not be officially noticed. In re Eynde, 178 USPQ 470, 474 (CCPA 1974). In addition, officially noticed fact cannot provide the totality of evidence to support a rejection. In re Ahlert, 165 USPQ 418, 421 (CCPA 1970). If the Examiner maintains the present rejection of claim 12, he is requested to provide appropriate evidence to substantiate his position that "double fold 'c' shaped fold type is old, well known, and available in the art."

Moreover, there is no showing whatsoever that double fold "c" type labels have even been produced for insertion into a newspaper. There is no evidence of record that supports such a contention.

Regarding claim 13, Stemmler does not disclose interfolding of sheets that include at least one fold line and at least one fold, respectively, and that further include a plurality of spaced-apart, transversely extending perforation lines.


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Regarding claims 14 and 15, dependent on claim 11, the mere fact that Stemmler discloses the use of knife rolls or perforations in its apparatus does not supply the hereinabove noted deficiencies of Stemmler as reference against any of claims 11-15. The interfolded sheets shown by Stemmler are clearly different from those defined in the present claims because they lack the longitudinal fold line and at least one fold, respectively.

The foregoing discussion is deemed to distinguish fully the present claims from the applied references and to dispose of all issues in this case. Early passing of this application to issue is requested.

Respectfully submitted,

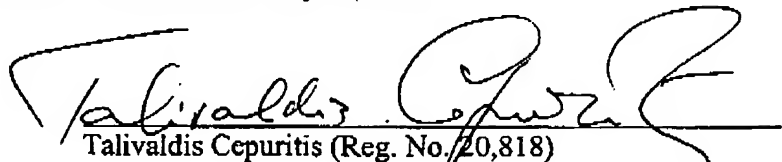
May 23, 2006

By   
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